

REMARKS

This application has been carefully reviewed in light of the Official Action mailed May 5, 2006. Claim 1 is amended above. Claims 1 and 3-14 are now pending in this case.

Applicant respectfully submits that entry of the above amendment will place all claims in this case in condition for allowance. Applicant therefore requests entry of the above amendment and reconsideration of this application in view of the amendment and the following remarks.

In the Official Action, the Examiner rejected the following claims under 35 USC 103 (a) as being unpatentable: claims 1, 3, 5, 6, 7, and 14 as being unpatentable over U.S. Patent No. 3,661,144 to Jensen ("Jensen") in view of U.S. Patent No. 6,135,984 to Dishler ("Dishler") in further view of U.S. Patent No. 6,419,654 to Kadan ("Kadan"); claim 4 as being unpatentable over Jensen in view of Dishler in view of Kadan as applied to claim 1, and in further view of U.S. Patent No. 5,795,323 to Cucin ("Cucin"); claim 8 as being unpatentable over Jensen in view of Dishler in view of Kadan as applied to claim 1, and in further view of U.S. Patent No. 3,439,675 to Cohen ("Cohen"); claims 9-10 as being unpatentable over Jensen in view of Dishler in view of Kadan as applied to claim 1, and in further view of U.S. Patent No. 5,246,436 to Rowe ("Rowe") and further in view of U.S. Patent No. 6,193,714 to McGaffigan et al. ("McGaffigan"); claim 11 as being unpatentable over Jensen in view of Dishler in view of Kadan in view of Rowe and further in view of McGaffigan as applied to claims 9 and 10, and in further view of U.S. Patent No. 6,325,798 to Edwards et al. ("Edwards"); claim 12 as being unpatentable over Jensen in view of Dishler in view of Kadan in view of U.S. Patent No. 5,242,386 to Holzer ("Holzer"); and claim 13 as being unpatentable over Jensen in view of Dishler in view of Kadan. Amended claim 1 requires, in a vitreoretinal instrument,

(a) a handle; and

(b) a cannula coupled to said handle comprising:

(1) a curved distal portion having a plane of curvature and a side port disposed at an angle of about 90 degrees to said plane of curvature, said side port for disposing in a subretinal space for aspirating subretinal fluid; and

(2) a second port disposed sufficiently away from said side port so that said second port may be used for aspirating a second fluid from said vitreous cavity without removing said first port from said subretinal space;

(c) a first flexible tubing having a distal end fluidly coupled to said side port and a proximal end for fluidly coupling to a vacuum source;

(d) *a second flexible tubing having a distal end fluidly coupled to said second port and a proximal end for fluidly coupling to said vacuum source; and*

(e) *a compression valve disposed on said handle for selectively opening and closing said second flexible tubing, wherein said compression valve comprises a piston which compresses said second tubing against a tubing support member when in a closed position.*

(emphasis added). As is disclosed in the subject specification, such an instrument provides significant advantages over conventional vitreoretinal surgical instruments, including, ease of use for the surgeon, the ability to completely remove subretinal fluid, reduced likelihood of retina, retinal pigment epithelium, or choroid damage, and the ease of achieving proper repositioning of retinal tears or detachments. *See, e.g.*, subject specification, page 9, line 22 through page 10, line 3; page 7, line 15 through page 9, line 2.

Jensen, Dishler, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, and Holzer all fail to teach limitation (d) of amended claim 1. In contrast, Jensen, Dishler, Cucin, Cohen, Rowe, McGaffigan, Edwards, and Holzer are all totally silent regarding these claim limitations. Kadan merely discloses

[h]andpiece 10 also has irrigation and suction channels 26 and 28 having fittings or luers 30 and 32 for quickly attaching irrigation and suction tubing.

See Kadan, column 6, lines 46-63 and column 8, lines 15-22. This disclosure clearly differs from the requirement of first *and* second flexible tubing *each* having a proximal end for fluidly coupling to *a vacuum source*, as required by amended claim 1. In addition, Jensen, Dishler, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, and Holzer all fail to teach limitation (e) of amended claim 1. Again, Jensen, Dishler, Cucin, Rowe, McGaffigan, Edwards, and Holzer are all totally silent regarding these claim limitations. Kadan merely discloses *trumpet valves* 12 and 14 comprised of stems 86 and 88, and biased by springs 90 and 92 into a normally closed position, not *a compression valve* which “compresses said second tubing against a tubing support member when in a closed position”, as required by amended claim 1. *See* Kadan, column 8, lines 15-32. For at least these reasons, amended claim 1, and its dependent claims 3-14, are patentable over Jensen, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, Holzer, and Dishler.

Furthermore, there is no suggestion in the prior art to modify the teachings of Jensen, Dishler, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, and Holzer so as to reach the requirements of amended claim 1, much less its associated benefits.

Absent such suggestion, any such modification would necessarily be based on the improper hindsight application of Applicant's own teachings. For this reason, claim 1, and its dependent claims 3-14, are patentable over Jensen, Dishler, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, and Holzer.

Applicant has made an earnest attempt to place this case in condition for full allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration of this application and full allowance of all claims remaining in this case. If the Examiner has any questions regarding this amendment, please contact the undersigned at (817) 568-6029.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "W. David Lee". The signature is fluid and cursive, with the first name "W." and last name "Lee" clearly distinguishable.

W. David Lee
Reg. No. 39,743

Alcon Research, Ltd.
IP Legal TB 4-8
6201 South Freeway
Fort Worth, Texas 76134-2099
Tel: 817/568-6029
Fax: 817/551-4610